



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,254	01/23/2004	Raymond Allan Pickup	075200.0101	8022
7590	02/08/2005		EXAMINER CRANE, DANIEL C	
Paul R. Morico Baker Botts L.L.P. One Shell Plaza 910 Louisiana Houston, TX 77002-4995			ART UNIT 3725	PAPER NUMBER
DATE MAILED: 02/08/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,254	<b>Applicant(s)</b> PICKUP ET AL.	
	<b>Examiner</b> Daniel C Crane	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25 and 27-42 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-8, 10-12, 18-20, 22-24 and 26 is/are rejected.
- 7) ☐ Claim(s) 9, 13-17 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **REJECTION OF CLAIMS ON FORMAL MATTERS**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Failure to provide an adequate description of the invention relating to a pair of handles movably mounted to the body of the tool with one of the handles being secured to the body. This appears to be contrary subject matter.

## **REJECTION OF CLAIMS OVER PRIOR ART**

Claims 1-5, 7, 8, 18, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Malagnoux (4,313,333). Figures 5-7 show that the moving member 5 is slidably mounted to the body 1 and driven by pivoted handles 12a, 13a. The anvils are shown at 4a and 5b. The cooperable formations 7, 8 and 9 facilitate movement of the anvils such that the handles move with the anvils.

Claims 1-5, 7, 8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Schiffmann (GB 872,228). Figures 1 and 2 show that the anvils 3 and 5 are movable relative to one another and are operated by a pair of pivotable handles 10 that are geared to the moving

Art Unit: 3725

member 4. The first gear 12 is shown to be connected to one of the handles and a second gear or other gear 12 is shown to be engaged to the moving member 4 through cooperating formations 11 and 12. Since there are two gear members 18 and both are connected to the handles and to the movable member 4, it can be said that one of the gear members is connected to one of the handles and movable therewith and the other gear member is connected to the movable member and movable therewith. Accordingly, claims 10-12 do not define over Schiffmann's showing.

Claims 1-5, 7, 8, 18-20 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Gayter (GB 2,169,828). The moving member 20 is slidably mounted to the body 3 and is moved by pivoting handles 6, 7 so as to separate a leading clip 42 from a series of taped clips within the arcuate magazine 19. The anvil is inherently designed to separate the leading clip from the clip magazine. Since the tool is assembled from a plurality of parts to form the integrated tool assembly, it is evident that the parts can be disassembled. As to claim 23 the magazine can be reattached in a "plurality of angular dispositions" each time the magazine is disassembled and reassembled. Aluminum tools are known in the art for their reduced weight. Accordingly, such a provision within Gayter's tool to lighten the tool would have been obvious to the skilled artisan in light of this conventionally known motivation.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gayter (GB 2,169,828). While Gayter does not indicate that the anvil 25 is provided with a severing implement to separate the leading magazine from the clip magazine, it is obvious that such would have been contemplated so as to easily separate the leading clip from the clip magazine.

Art Unit: 3725

Furthermore, such a feature is common in the art. Accordingly, it would have been obvious to the skilled artisan at the time of the invention to have modified Gayter's anvil 25 by providing severing implement on the anvil 25 so as to cleanly separate each leading clip from the clip magazine as well known in this art.

### **RESPONSIVE TO APPLICANT'S COMMENTS**

Applicant's comments have been carefully considered.

The fact that the anvil in Malagnoux and Gayter's device slides freely with respect to the body does not preclude the applicability of the references against the claims. Contrary to applicant's arguments, the anvil in these teachings is "connected" to the moving member 7 of Malagnoux and the moving member 5b of Gayter. As long as a "connection" is provided, whether it is slidable or fixed, the anvil is connected to the moving member. Furthermore, the cooperable formations of Malagnoux, which encompass the links 8 and 9 and the connecting pin 7 cause the anvil 5b to move with the handles. This is also the case with Gayter's tool where the cooperable formations 5, 5a and pin 5b movable member 20.

Contrary to applicant's comments, Malagnoux and Gayter show cooperating formations in the form of links and pins that facilitate the movement of the movable member relative to the body of the tool. Furthermore, Schiffmann shows cooperable formations in the form of cooperating gears and connecting pins connecting the gears to the movable member so as to facilitate movement of the movable member. Clearly, Schiffmann's gears, while they cooperate with one another, still "cooperate" with the movable member by virtue of their pin connection to the movable member, thus, permitting movement of the movable member and its anvil.

Accordingly, the claimed invention does not define over the prior art of record.

#### **INDICATION OF ALLOWABLE SUBJECT MATTER**

Claims 9, 13-17 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 25 and 27-42 are allowed.

#### **FINAL OFFICE ACTION**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Art Unit: 3725

## INQUIRIES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is **(571) 272-4516**. The examiner's office hours are 6:30AM-5:00PM, Tuesday through Friday. The examiner's supervisor, Mr. Derris Banks, can be reached at **(571) 272-4419**.

Documents related to the instant application may be submitted directly to Group 3700 by facsimile transmission at all times. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Group 3725 Facsimile Center number is **(703) 872-9306**.

DCCrane  
February 6, 2005



**Daniel C. Crane**  
Primary Patent Examiner  
Group Art Unit 3725